

Serial No.: 09/654,212  
Filed: September 1, 2000

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Appeal Brief  
S. Zimmerman

AC-001

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Anthony N. CABOT

) Group Art Unit 3711

Serial No. : 09/654,212

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Filed : September 1, 2000

For : MULTIWAY POKER GAME METHOD  
AND APPARATUS

7/23/02

Examiner : Nini F. Legesse

(Date)

Victor J. Gallo

**APPELLANT'S BRIEF**

Appellant, pursuant to 37 C.F.R. § 1.192 submits his brief in support of his appeal of the final rejection of all Claims 1-7 and 21-32 of the above-identified application, a copy of which are provided in the Appendix.

1. **Real Party in Interest**

The appellant owns all right, title and interest in and to the patent application which is the subject matter of this appeal.

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2. Related Interferences and Appeals

The appellant is not presently aware of any related appeals or interferences.

3. Status of the Claims

All pending Claims 1-7 and 21-32 pending as of the final Office Action dated October 3, 2001, stand finally rejected under 35 U.S.C §§ 102(e) and 103. The final rejection of all Claims 1-7 and 21-32, as amended in the Amendment to the First Office Action, are the subject matter of this appeal.

4. Status of Amendments

The appellant on May 21, 2001 submitted a response to a first office action canceling certain claims (as part of an election/restriction requirement) and amending others and submitting new claims 21-32. By an Office Action dated October 3, 2001, all claims were finally rejected. An amendment after final was tendered but not entered.

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1           5.     Summary of Invention

2  
3           Appellant's invention comprises an apparatus and method for a NxN array poker  
4 card game. However, the (first) examiner imposed a restriction requirement that  
5 included the method claims in one group and the apparatus claims in the other group.  
6 The former group was elected with traverse, and that is the group which is on appeal.  
7 The elected claims, along with new method claims presented by way of amendment are  
8 set forth in an appendix to this brief.  
9

10          Appellant's method for playing a poker game is disclosed, comprising, dealing,  
11 face up, a NxN array of cards, selecting none, some, or all of the cards to be held in the  
12 NxN array of cards, dealing new cards to replace unselected cards, and determining the  
13 poker hand rankings of predefined N card arrangements (Pg 7, lines 11-17)  
14 (References are to the page and line of the specification unless otherwise indicated).  
15 Appellant's method for an NxN array poker card game (or multiway poker game) is a  
16 draw poker game utilizing, preferably, one standard deck of 52 cards (Pg 3, lines 16-  
17 17). The game is played, preferably, by arranging 25 cards in five rows and five  
18 columns (5x5) and alternately, the game can be played with nine cards arranged in  
19 three rows and three columns (3x3) (Pg 4, lines 1-4).  
20

21          In the 25-card arrangement, the player has the option of wagering on one to 12  
22 paylines (Pg 4, lines 6-7). That is, in a 5x5 array, five rows of cards are available as  
23 paylines, five columns of cards are available as paylines, and two diagonal sets of five  
24 cards are available as paylines (Pg 4, lines 6-10). The player can bet on any number of  
25 the lines from one through 12, but the order in which the lines may be purchased may

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1 be limited to a predefined order (Pg 4, lines 15-17). In short, the game is played by a  
2 player wagering on one or more of the paylines presented and then 25 cards are  
3 presented face up from a 52 card deck in the positions of the 5x5 array (Pg 11, lines 20-  
4 23, Pg 12, line 1). The player may then hold some, all, or none of the cards (Pg 12, lines  
5 1-2). Those cards not held are discarded and replaced from the deck (Pg 12, lines 2-3).  
6 The poker hand ranking of each payline wagered upon is determined and winning  
7 hands are paid according to a pay table and the amount wagered (Pg 12, lines 3-5).  
8 The nine-card, 3x3 arrangement may be played in a similar fashion, but would  
9 preferably allow for eight paylines; three rows, three columns, and two diagonals (Pg  
10 17, lines 8-9).  
11

12  
13 6. Issues Presented for Review  
14

15 The following are the issues presented by this Appeal.  
16

17 A. §102 (e) Rejection  
18

19 1. Whether claims 1-2, 4-6, 21-26 and 29-32 are anticipated by  
20 Holmes, U.S. Patent 6,220,959 ("Holmes '959").

21 2. Whether claims 24-32 are anticipated by Holmes '959 on a  
22 separate basis from 1 above.  
23  
24  
25

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1 B. 103(a) Rejection

2  
3 1. Whether claims 3, 27, and 28 are obvious over Holmes '959  
4 in view of Dietz, II, U.S. Patent 5,704,835 ("Dietz, II '835"); and

5 2. Whether claim 7 is obvious over Holmes '959.  
6

7  
8 7. Grouping of Claims  
9

10 Claims 1-2, 4-6, 21-26 and 29-32 stand or fall together (Claim 1 being identified  
11 as the suggested representative claim), claims 24-32 stand or fall together (claim 29  
12 being identified as the suggested representative claim), claims 2, 27, and 28 stand or  
13 fall together, and claim 7 stands or falls by itself.

14 The reasons why appellant believes the four groups of claims to be separately  
15 patentable are as follows. Claims 1-2, 4-6, 21-26 and 29-32 stand finally rejected under  
16 35 USC §102(e) and are all subject to a first ground of rejection. Claims 24-32 stand  
17 finally rejected under 35 USC §102(e) and are all subject to a second ground of  
18 rejection. Claims 2, 26, and 28 stand finally rejected under 35 USC §103(a) and are  
19 each subject to a first ground of rejection. Claim 7 stands finally rejected under 35 USC  
20 §103(a) and is subject to a separate second ground of rejection.  
21  
22  
23  
24  
25

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1           8.     Argument

2           A.     The Section 102(e) Rejections of Claims 1-2, 4-6, 21-26 and 29-32

3  
4           The Examiner has rejected claims 1-2, 4-6, 21-26, and 29-32 under 35 USC  
5 §102(e) as being anticipated by Holmes '959. Inter alia, the Examiner contended that  
6 Applicant's element of "selecting none, some, or all of the cards to be held in the NxN  
7 array of cards of any said cards within said NxN array" is met by Holmes '959 at Column  
8 4, lines 43-46. However, column 4, lines 43-46 state:

9  
10           "... from deck C, row 160 is dealt from deck D and row 180 is dealt from  
11 deck E. Alternatively, all of the cards can be dealt from a single deck of  
12 cards or all the cards can be dealt from two or more multiple decks of  
13 cards that have been all ...."

14           For anticipation, a single prior source or reference must contain all of the  
15 essential claimed elements. Chisum, Chisum on Patents § 3.02, Gechter v. Davidson,  
16 116 F.3<sup>rd</sup> 1454; 43 USPQ2d 1030 (Fed. Cir. 1997). Anticipation cannot lie where an  
17 element cannot be performed. ". . . [A]nticipation requires that each and every element  
18 of the claimed invention be disclosed in a single prior art reference." Akzo N.V. v.  
19 United States ITC, 808 F.2d 1471, 1 U.S.P.Q.2d 1241 (Fed. Cir. 1986). ". . . [A]nd must  
20 be arranged as in the claim[s] . . ." Carella v. Starlight Archery & Pro Line Co., 804 F.2d  
21 135, 231 U.S.P.Q. 644 (Fed. Cir. 1986). In addition, ". . . [the] absence from the  
22 reference of any claimed element negates anticipation." Kloster Speedsteel AB v.  
23 Crucible Inc., 793 F.2d 1565, 230 U.S.P.Q. 81 (Fed. Cir. 1986).

24           Appellant fails to appreciate this reference in light of the element at issue. In  
25 particular, this reference fails to address in any way Appellant's element of:

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1 (in the case of Independent Claim 1) "selecting none, some, or all of the  
2 cards to be held in the NxN array of cards of any said cards within said  
3 NxN array";

4  
5 (in the case of Independent Claim 21) "selecting some, none, or all of any  
6 of the cards within said NxN array of cards to be held";

7  
8 (and in the case of Independent Claim 29) "permitting a player to hold  
9 none, some, or all of any of said 25 cards."

10 The reference addresses, on the other hand, cards purportedly being dealt from a single  
11 deck (to be addressed with respect to a different element below). Thus, the Examiner  
12 has completely failed to point out any support in Holmes '959 for this element. It is  
13 Appellant's contention that this is due to the fact that no such support can be found in  
14 Holmes '959 for this key element of Appellant's invention distinguishing it from Holmes  
15 '959.  
16

17 In particular, it is clear from column 5, lines 28-31, that a player is REQUIRED to  
18 hold ONLY one card per row and that card is then duplicated somewhere within the row.

19 In the preferred embodiment of the present invention, the player  
20 now selects one of the cards in each horizontal row to be held. Each card  
21 that is held by the player is duplicated once into an adjacent position on  
22 the same row.

23 Holmes '959, column 5, lines 28-31 (emphasis added). This is the heart of Holmes'  
24 invention. Being limited to holding one card per row is not the same as being able to  
25

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1 hold ANY cards in an NxN array, which Appellant's invention provides and the claims  
2 callout. Thus, anticipation simply cannot be found.

3 It is respectfully submitted that claims 1, 21, and 29 are not anticipated by  
4 Holmes '959. Reversal of the rejection of claims 1, 21, and 29 is requested. Further in  
5 view of the dependency of claim 2, 4-6, 22-26, and 30-32, it is submitted that these  
6 claims are likewise not anticipated. Reversal of the rejection of claims 2, 4-6, 22-26,  
7 and 30-32 is requested.  
8

9  
10 **B. The Section 102 Rejections of claims 24-32**

11  
12 Next, the Examiner contended that Holmes teaches dealing new cards to replace  
13 the cards not held (presumably from a standard 52 card playing deck). Appellant hereby  
14 incorporates by reference the law cited in the preceding section as if fully delineated  
15 here.  
16

17 With specific reference to Claims 24 and 29, Appellant contends that Holmes  
18 '959 is inoperative when attempted with a single deck of standard playing cards. For  
19 example, if one of the rows dealt includes four of a kind, in Holmes the player is  
20 required to hold one card and replace the rest. If the player holds one of the cards from  
21 the four of a kind, how does that card get duplicated (there are no more cards in the  
22 deck of that type)? It is known in the art that standard cards include four suits, resulting  
23 in four of each card (one per suit). Where is the duplicated card coming from and where  
24 are the replacement cards for the un-held cards coming from? Holmes '959 does not  
25 say. Holmes suggests dealing from a single deck, but if one looks closely, Holmes '959



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1 does not describe where the duplicated cards and the replacement cards come from.  
2 Thus, to put it clearly, Holmes '959 cannot anticipate that which it does not teach.  
3 Furthermore, however, Holmes '959 is inoperative with a normal deck of playing cards.

4 It is respectfully submitted that claims 24 and 29 are not anticipated on the  
5 separate grounds enunciated above. Thus, reversal of the rejection of claims 24 and 29  
6 may be separately found if necessary. Further in view of the dependency of claims 25-  
7 28 and 30-32, it is submitted that these claims are likewise separately not anticipated.  
8

9  
10 **C. The Section 103(a) Rejections of Claims 3, 27, and 28**

11  
12 Claims 3, 27, and 28 have been rejected as being obvious over Holmes '959 in  
13 view of Dietz, II '835.

14 The Examiner bears the initial burden of factually supporting a *prima facie* case  
15 of obviousness. MPEP § 2142. To support the conclusion that the claimed invention is  
16 directed to obvious subject matter, either the references must expressly or impliedly  
17 suggest the claimed invention or the examiner must present a convincing line of  
18 reasoning as to why the artisan would have found the claimed invention to be obvious in  
19 light of teachings of the references. MPEP §2142.  
20

21 To establish a *prima facie* case of obviousness, there must be some **suggestion**  
22 **or motivation** (either in the references themselves or in the knowledge generally  
23 available to one of ordinary skill in the art) **to modify the reference** teachings. The  
24 prior art reference (or references when combined) must teach or suggest **all the claimed**  
25 limitations. MPEP §2143. Obviousness can only be established by combining or

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1 modifying the teachings of the prior art to produce the claimed invention when there is  
2 some teaching, suggestion or motivation to do so found either in the references  
3 themselves or in the knowledge generally available to those skilled in the art. In  
4 re Fine 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP §2143.01. A statement that  
5 modifications of the prior art, to meet the claimed invention, would have been well within  
6 the ordinary skill in the art at the time the claimed invention was made, is not sufficient  
7 to establish *prima facie* obviousness without some **objective reason to combine the**  
8 **teachings of the prior art.** MPEP §2143.01. Further, if the proposed modification of  
9 the prior art would **change the principle of operation** of the prior art invention being  
10 modified, then the teachings of the reference are insufficient to render the claims *prima*  
11 *facie* obvious. MPEP §2143.01.

13 The Examiner contends that Dietz, II '835 discloses a game where the NxN array  
14 of cards is a 3x3 (column 3, lines 51-53) and that Dietz, II '835 also discloses three card  
15 diagonal groups (refer Fig. 2).

17 The Examiner noted that Holmes fails to teach a 3x3 array of cards, diagonal  
18 paylines for three card groups, and purchase of three card groups in a sequential order.  
19 The Examiner has taken Holmes '959 and Dietz, II '835 out of context to try to force  
20 them together by use of impermissible hindsight. "When prior art references require  
21 selective combination by the court to render obvious a subsequent invention, there must  
22 be some reason for the combination other than the hindsight gleaned from the invention  
23 itself." Interconnect Planning Corp. v. Feil, 774 F.2d at 1143, 227 U.S.P.Q. at 551.  
24 Citing ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577 & n. 14,  
25 221 U.S.P.Q. 929, 933 & n. 14 (Fed. Cir. 1984).

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1 Dietz, II '835 teaches a slot machine game having traditional slot reels and reel  
2 strips (see column 5, lines 24-35). Dietz, II '835 neither teaches nor suggests a poker  
3 game. Holmes '959 does not suggest combining with slot machines and Dietz, II '835  
4 does not suggest combining with poker games. "Something in the prior art as a whole  
5 must suggest the desirability and thus the obviousness of making the combination."  
6 Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 780 F.2d 1452,  
7 1462, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984). In fact, the opposite is true. Dietz, II '835  
8 distinguishes slot machines from poker games (see column 1, lines 16-23). Dietz, II '835  
9 teaches away from combining with poker games. When a cited reference not only fails  
10 to teach the element in question, and instead teaches away from it, that reference  
11 cannot be deemed applicable. Furthermore, appellant's invention solves a different  
12 problem than the references, and such different problem is recited in the claims. In re  
13 Wright, 6 U.S.P.Q.2d 1959 (1988). To wit, appellant's invention teaches a novel poker  
14 game and has nothing to do with reel-type slot games.

15  
16  
17 Reversal of the rejection of claims 3, 27, and 28 is respectfully requested.

18  
19 **D. The Section 103(a) Rejections of Claim 7**

20  
21 The Examiner rejected claim 7 under 35 USC §103(a) as being unpatentable  
22 over Holmes. The Examiner contended that 12 said N card arrangements disclosed by  
23 Holmes opens the door for players to extend the complexity of the game to whatever  
24 levels they choose to play. The Examiner further contended that it would have thus  
25 been obvious to one having ordinary skill in the art at the time the invention was made

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1 to purchase 12 N card arrangements sequentially in a predetermined order for a more  
2 challenging game where the outcome (win or loss) becomes satisfying. Appellant  
3 hereby incorporates by reference the law cited in the preceding section as if fully  
4 delineated here.

5       However, the Examiner failed to cite to any suggestion in Holmes to purchase  
6 the 12 N card arrangements in a predetermined order. Appellant submits that the  
7 Examiner has cited no reference to Holmes '959 to support the contention because no  
8 such support can be found in Holmes '959. A statement that modifications of the prior  
9 art, to meet the claimed invention, would have been well within the ordinary skill in the  
10 art at the time the claimed invention was made, is not sufficient to establish *prima facie*  
11 obviousness without some **objective reason to combine the teachings of the prior**  
12 **art.** MPEP §2143.01. Simply put, the Examiner has failed to meet this burden and  
13 could not meet this burden because nothing in Holmes '959 supports the Examiner's  
14 contention.  
15

16       Reversal of the rejection of claim 7 is respectfully requested.  
17

18  
19       **9. Summary**  
20

21       For the foregoing reasons, appellant believes that the examiner's rejections of  
22 claims 1-7 and 21-32 were erroneous, and reversal of the examiner's position is  
23 respectfully requested.  
24  
25

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Respectfully submitted,



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## APPENDIX

1. A method for playing a poker game, comprising in combination:

dealing, face up, a NxN array of cards;

selecting none, some, or all of the cards to be held in the NxN array of  
cards of any said cards within said NxN array;

dealing new cards to replace unselected cards within said NxN array; and

determining the poker hand rankings of predefined N card arrangements.

2. The poker game of claim 1 wherein said NxN array of cards is a 5x5 array of cards.

3. The poker game of claim 1 wherein said NxN array of cards is a 3x3 array of cards.

4. The poker game method of claim 1 further comprising placing a wager on at least one  
said N card arrangements prior to the initial dealing of the cards.

5. The poker game method of claim 4 further comprising determining whether said at  
least one said N card arrangements wagered on includes a winning outcome after  
determining the poker hand rankings and if so, paying the player according to a pay  
table.

6. The poker game method of claim 2 further comprising 12 said N card arrangements  
arranged as five vertical lines, five horizontal lines, and two diagonal lines.

7. The poker game method of claim 6 further comprising allowing the purchase of said  
12 said N card arrangements sequentially in a predetermined order.

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- 1 21. A method for playing a poker game, comprising in combination:  
2                   dealing, face up, a NxN array of cards;  
3                   selecting some, none, or all of any of the cards within said NxN array of  
4 cards to be held;  
5                   replacing unselected cards with new cards; and  
6                   determining the poker hand rankings of predefined N card arrangements  
7 wherein any said card is implicated in at least two N card arrangements of hands.  
8  
9 22. The method for playing the poker game of claim 21 further comprising wagering on  
10 one or more said N card arrangements prior to said dealing step.  
11  
12 23. The method for playing the poker game of claim 22 further comprising comparing  
13 said determined poker hand rankings to a pay table and paying a multiple of said wager  
14 according to a payout schedule in said pay table.  
15  
16 24. The method for playing the poker game of claim 23 further comprising providing a  
17 52 card deck for dealing and replacing said cards.  
18  
19 25. The method for playing the poker game of claim 24 defining N as five and including  
20 at least each five card row and each five card column in said predefined N card  
21 arrangements.  
22  
23 26. The method for playing the poker game of claim 25 further including at least said  
24 five card diagonal groups of cards in said predefined N card arrangements.  
25  
26 27. The method for playing the poker game of claim 24 defining N as three and  
27 including at least each three card row and each three card column in said predefined N  
28 card arrangements.

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1 28. The method for playing the poker game of claim 27 further including at least said  
2 three card diagonal groups of cards in said predefined N card arrangements.

3  
4 29. A method for playing a poker game utilizing a standard 52 card playing deck,  
5 comprising in combination:

6 dealing 25 cards face up in a five row by five column arrangement;

7 permitting a player to hold none, some, or all of any of said 25 cards;

8 replacing each card not held with a card from the remaining cards in the  
9 deck; and  
10

11 comparing each five card row and column group of cards to predefined  
12 poker rules to determine ten hand rankings.

13 30. The method for playing the poker game utilizing a standard 52 card playing deck of  
14 claim 29 further comprising additionally comparing two diagonal five card groups  
15 extending one from a near top corner to a far bottom corner of said five row by five  
16 column arrangement of cards and another from a far top corner to a near bottom corner  
17 of said five row by five column arrangement of cards to predefined poker rules to  
18 determine an additional two hand rankings.  
19

20 31. The method for playing the poker game utilizing a standard 52 card playing deck of  
21 claim 30 further comprising receiving a wager from a player for each row, column, or  
22 diagonal group of five cards prior to dealing said cards.

23 32. The method for playing the poker game utilizing a standard 52 card playing deck of  
24 claim 31 further comprising paying the player according to a pay table as related to said  
25 hand rankings and said wager.



PLEASE ACKNOWLEDGE RECEIPT OF:

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Applicant: Cabot

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For: Multiway Poker Game Method and Apparatus  
AC-001

